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In re application of
Morton-Finger et al.
Serial No. 10/772,162
Filed: February 3, 2004
For: MULTI-LAYER MONOFILAMENT AND PROCESS FOR MANUFACTURING A
MULTI-LAYER MONOFILAMENT

:
:
: DECISION ON
: PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO REFUND THE EXTENSION FEE PAID on November 22, 2004.

On October 15, 2004, a restriction requirement was mailed to Applicants. The office action contained a requirement that "[I]f group I is elected, applicant is required to elect a single disclosed species for claim 5, 6, and 7." Applicants responded with an election filed November 2, 2004. In the response, applicant elected Group I and elected the species of claim 7. The examiner held that the response was non-responsive and sent out an office action requiring a new election. The office communication did not give applicants any time period for response but rather maintained the time period set forth in the original restriction requirement of October 15, 2004. Applicant responded to the new requirement on November 22, 2004 along with a request for a one month extension of time which was granted.

On November 22, 2004 the instant petition under 37 CFR 1.181 was timely filed to formally request a refund of the extension of time fee paid on November 22, 2004.

DECISION

Section 714.03 of the MPEP states in part:

714.03 [R-2] Amendments Not Fully Responsive, Action To Be Taken
37 CFR 1.135. Abandonment for failure to reply within time period.

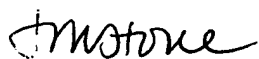
(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Where the amendment is bona fide but contains a serious omission, the examiner should:

A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or

B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

In the instant case, it is clear that the omission of the required election of species for claims 5, 6 and 7 was inadvertent. The language set forth in the original restriction requirement was confusing in that it stated a "single disclosed species for claims 5, 6 and 7" was required. It is reasonable to conclude that the examiner was asking for a single specie to be elected among the three claims rather than one specie from each claim. Because the omission was inadvertent, the examiner should have given Applicants a 30 day time period to respond to the new requirement mailed November 16, 2004. Accordingly, there was no need for an extension of time to be paid and therefore, the instant petition to refund the fee is **GRANTED**.



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